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EXAMINER

MATTHEWS, WILLIAM H

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/977,826
Filing Date: October 15, 2001
Appellant(s): GOICOECHEA ET AL.

Joshua Cohen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5-28-09 appealing from the Office action mailed 3-24-08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Interference No. 104,083

Interference No. 104,192

Scimed Life Systems, Inc. v. Medtroninc Vascular, Inc., et al., Civil Case No. 01-2015 (RJL), and including 9 Orders or Opinions attached as Tabs 3-11.

Boston Scientific Scimed, Inc. (formerly known as Scimed Life Systems, Inc.) v. Medtroninc Vascular, Inc. (also known as Medtronic AVE), United States Court of Appeals for the Federal Circuit, No. 2006-1434.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Merriam Webster's Collegiate Dictionary, 10th Edition, 2001, pp. 14 and 636.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 20,22-25,27-33,39,41,43-49,54-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Independent claims 54 and 56 each recite vertices that abut which is not disclosed in the specification. The specification only discloses juxtaposed vertices. Juxtapose is defined by Merriam Webster's Collegiate Dictionary, 10th Ed. as: to place side by side and is synonymous with "adjacent". Adjacent is described as: may or may

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not imply contact but always implies absence of anything of the same kind in between.

Furthermore, the attachment mechanisms at page 10 lines 16-23 do not imply the apices must abut (as a weld or adhesive means would imply).

4. Independent claim 54 recites “non-helical” in combination with each hoop being substantially perpendicular and having connected apices. The specification only discloses embodiments wherein each hoop is substantially perpendicular and has connected apices in conjunction with a helical “offset” feature (see figure 2A, 3, 4A and the description at page 24 lines 5-19). The term non-helical implies a lack of helical features, whereas the “offset” feature is clearly helical.

5. Independent claim 56 recites “the vertices of each hoop pointed in the axial direction lie in a common plane perpendicular to the longitudinal axis of the tubular member” in combination with “axially abutting vertices of adjacent hoops”, which is not disclosed in the specification. If “abutting vertices” were assumed to be supported by the original disclosure, the specification would only support “substantially perpendicular” for the combination (see page 23, lines 11-23). “Perpendicular” is described for the straight stents of figures 22-23, but the “perpendicular” embodiment of figures 22-23 is described for “one or more adjacent hoops” rather than each or all hoops as claimed (see page 44 lines 14-26, in particular line 23).

6. Claims 20,22-25,27-33,39,41,43-49,55, and 57 depend from, and include the limitations of claims 54 and 56 as described above.

(10) Response to Argument

Regarding claim 54 and the claimed phrase “means for securing an apex of one hoop to an abutting juxtaposed apex of a neighboring hoop”, Appellant acknowledges at pages 8-11 of the Brief that the specification lacks explicit disclosure of abutting apices. Appellant relies upon the disclosure of "juxtaposed" in combination with the figures which may show contact between the apices. Appellant further points to the means for securing adjacent apices (suture, loop, rings), however none of the cited passages require contact between the apices. Examiner maintains that the means for securing apices only teach they connect apices, and do not require the apices to contact each other. Furthermore, although the figures may appear to show contacting/abutting apices, the specification fails to describe the apices as contacting. Thus, Examiner maintains the amendment to claim 54 filed on 08/08/2007 constitutes new matter.

Regarding claim 54 and the claimed phrase “non-helical”, as introduced in the amendment on 08/08/2007, Appellant contends the disclosure at page 9 of the specification of a helical embodiment and an alternative embodiment inherently provides support for a “non-helical” embodiment. Examiner disagrees. The passage cited by Appellant may suggest a substantially non-helical embodiment, but non-helical implies an embodiment lacking helical features. As described in the rejection, each of the embodiments possesses a helical offset feature. Appellant argues at page 13 of the Brief that “regardless of how the hoops are formed, and regardless of how one hoop flows into another hoop, the hoops themselves are non-helical”. This statement is not understood as the offsets are a part of the hoops and introduce a helical aspect the

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hoops (see figure 2A). For these reasons, Examiner maintains the amendment to claim 54 filed on 08/08/2007 constitutes new matter.

Regarding claim 56 and the claimed phrase “at least some of said vertices axially abut”, Appellant repeats that the specification and figures demonstrate the connected apices are abutting. Appellant further argues that Examiner’s statement regarding welds or adhesives is improper because two objects may contact without being welded or adhesively joined. Examiner notes that the comment regarding welds/adhesive was merely to show that a connection by suture loops or rings is not equivalent to a connection by weld or adhesive which would inherently required contact. In contrast, the disclosed means for connecting vertices (suture, loops, rings) imply a space is present between the vertices unless the means are tied tightly, but the specification is silent as to how loose or tight the connections are. Therefore, Examiner maintains the specification fails to provide sufficient support for abutting vertices since the specification only describe juxtaposed vertices and a connection means which does not inherently require contacting vertices.

Regarding claim 56 and the claimed phrase “the vertices of each hoop pointed in the axial direction lie in a common plane perpendicular to the longitudinal axis of the tubular member”, Appellant acknowledges the Examiner’s points with respect to the two different embodiments (Figures 1A/2A and Figures 22/23), neither of which independently supports the combination of “each hoop” and “perpendicular” (see page 15 of the Brief, last paragraph). Figures 1A/2A are described to have vertices being “substantially perpendicular” (page 23, lines 20-23), while Figures 22/23 only describe

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“one or more hoops” being perpendicular (page 44, lines 21-23). To overcome this deficiency, Appellant suggests the perpendicular hoops of Figures 22/23 could be incorporated into the stents of Figures 1A/2A since they are “formed in the same way”. Alternatively, Appellant states figure 1A show vertices lying in a perpendicular plane.

These arguments are not persuasive because Figure 1A is described as having vertices lying in a substantially perpendicular plane and Figure 2A shows the detailed construction of Figure 1A, wherein Figure 2A do not show vertices lying in a perpendicular plane. Furthermore, the disclosure of “formed in the same way” appears to describe a manufacturing process rather than an explicit disclosure that features of the separate embodiments may be interchanged. Finally, and most importantly, the specification only describes “perpendicular hoops” in the context of “one or more hoops” rather than “each or all hoops”. It is the Examiner’s opinion that this is because the vertical offset shown in Figures 2A, 3, and 4A prevents a truly perpendicular hoop of vertices, and thus it would not be possible to provide a stent wherein “each hoop is perpendicular” as claimed in claim 56. Furthermore, it is conceivable that the description of figures 22-23 as having one or more perpendicular hoops only describes the vertices on the ends of the stent.

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(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William H. Matthews/

Primary Examiner AU 3774

Conferees:

/DAVID ISABELLA/

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